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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/518,808	03/03/2000	Yoji Kawamoto	7217/31035	5769

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EXAMINER

NEURAUTER, GEORGE C

ART UNIT	PAPER NUMBER
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2143

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/26/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	09/518,808	KAWAMOTO ET AL.	
	Examiner	Art Unit	
	George C. Neurauter, Jr.	2143	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 December 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3 and 10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3 and 10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 2143

DETAILED ACTION

Claims 1, 3, and 10 are currently presented and have been examined.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 14 December 2006 has been entered.

Response to Arguments

Applicant's arguments filed 14 December 2006 have been fully considered but they are not persuasive.

The Applicant argues that Kawano does not teach where a user switches terminals after a request is made but before the response can be sent. However, The Applicant has not specifically pointed to the claim language where this language is recited in the claim and it appears to the Examiner that the claims do not recite and therefore require this particular embodiment. Although the claims are interpreted in light of the specification, limitations from the specification are not read

Art Unit: 2143

into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The Applicant also argues that Kawano does not disclose reformatting a response to accommodate a different terminal device. The Examiner respectfully disagrees. As shown previously in the Non-Final Rejection mailed 13 May 2005, Kawano does disclose this limitation.

Therefore, the rejections are maintained and apply to the currently presented claims.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by US Patent 6 697 836 B1 to Kawano et al.

Regarding claim 1, Kawano discloses a network system connecting a plurality of different types of user terminal devices (referred to throughout the reference as "clients") and

Art Unit: 2143

a network server ("service mediate server") via a known communication system, wherein each user terminal device comprises:

means for retrieving information from a removable memory ("IC card"; column 10, lines 33-38; column 10, lines 33-38) loaded into the terminal device; said removable memory storing user specific information ("service requester information") (column 10, lines 23-42), and

means for transmitting said user specific information and information identifying said terminal device ("client terminal information") as specific information ("service request message") when said removable memory is loaded, wherein said information identifying said terminal device includes terminal type attributes and media type attributes corresponding to said terminal device ("condition information" and "service interface"; column 5, lines 38-45; column 9, lines 35-47; see also Figure 3, element 1051c); (column 10, lines 23-42; column 11, lines 27-38) and

said network server comprises:

means for receiving said specific information transmitted by said terminal device used by said user, (column 11, lines 27-38)

Art Unit: 2143

means for registering said user specific information and said information identifying said terminal device included in said specific information as registered information, (column 7, lines 21-31; column 8, lines 24-45; column 11, lines 33-38)

means for updating said registered information identifying said terminal device corresponding to said user specific information, (column 7, lines 32-65; column 11, lines 12-19)

means for identifying a latest type of terminal device, based on said updated information by said means for updating, currently being used by said user and for authenticating said user by referring to said registered information, (column 7, lines 32-65; column 11, lines 12-19 and 39-53)

means for converting ("changing") message information addressed to said authenticated user to a data format compatible with said terminal device based on said terminal type attributes and said media type attributes of said terminal device currently being used by said user (column 2, lines 8-24; column 9, lines 25-47; column 11, line 54-column 12, line 14), and

means for transmitting the converted message information to said terminal device currently being used by said user.

(Abstract, specifically "The information received by [a server] is processed by the service mediate agent and the processed

Art Unit: 2143

information is transmitted to [a client]."; column 9, lines 25-47, specifically lines 65-66)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors.- In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary.

Art Unit: 2143

Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 3 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawano et al.

Regarding claim 3, Kawano discloses the network system according to claim 1.

Kawano does not expressly disclose wherein said means for registering erases said registered information when said removable memory means is extracted from said terminal device, however, Kawano does disclose the use of an memory means as a portable medium as shown above. Kawano also discloses wherein the memory means contains user specific information that uniquely identifies a user and contains information exclusive to the user (column 7, lines 21-31; column 8, lines 33-38).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to erase the registered information when the memory means is extracted from the terminal device as disclosed in Kawano. Kawano discloses the memory means as a portable medium, which means that the user uses the memory

Art Unit: 2143

means as a means to use his or her exclusive information to obtains service from a server for a temporary period of time. One of ordinary skill would recognize this fact and would have considered it obvious that the memory means would eventually be removed when the user no longer required the services of the server. It would logically follow that the registered user's information would no longer be valid at the terminal at which the user used the memory means to obtain service from the server and the user's information would be considered invalid and, at some point in time, erased by an express deletion or by being overwritten by new values.

Therefore, it would have been obvious to achieve the limitations as claimed.

Claim 10 is also rejected since claim 10 recites a network system that contains substantially the same limitations as recited in claims 1 and 3 in combination.

Conclusion

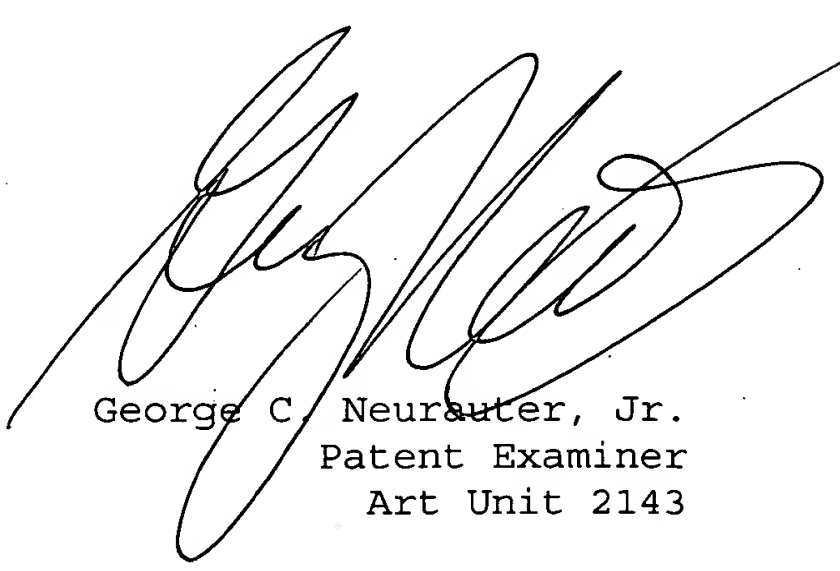
Any inquiry concerning this communication or earlier communications from the examiner should be directed to George C. Neurauter, Jr. whose telephone number is 571-272-3918. The examiner can normally be reached on Monday-Friday 9am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley, can be

Art Unit: 2143

reached on 571-272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



George C. Neurauter, Jr.
Patent Examiner
Art Unit 2143